

### **REMARKS**

Claims 1-32 are pending in the application. Claims 1-3, 7, 17-19 and 32 have been amended.

#### **Claim Objections**

Claim 7 has been objected to under 37 CFR 1.75(c) for improper dependent form. Claims 7 has been amended to recite “The process of claim 4 in which the hyperlink comprises links to a plurality of other traces.” Applicants respectfully submit that claim 7 now satisfies the requirements of 37 CFR 1.75(c).

#### **Claim Rejections**

- I. Claims 2-3, and 18-19 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite with regard to the phrase “generating intermediate data.” These claims have been amended to recite “generating data.” Applicants submit that claims 2-3, and 18-19 now conform to 35 U.S.C. § 112, second paragraph.
- II. Claims 1-32 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claim 1 has been amended to include computer elements. Claims 1, 17 and 32 have been amended to include practical use recited as “the new version of the trace used to navigate one or more trace log.” Applicants respectfully submit that claims 1-32 now satisfy 35 U.S.C. § 101.
- III. Claims 1-4, 8-13, 17-32 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over “Trace navigation and Analyzer Tool Prototype (High Level Design: First Draft)” by Chatterjee, hereafter referred to as Chatterjee, in view of U.S. Patent 6,282,01 to Wygodny.

Applicants submit that the Chatterjee document does not qualify as prior art. The MPEP states that:

Documents and items only distributed internally within an organization which are intended to remain confident are not ‘printed publications’ no matter

how many copies are distributed. *In re George*, 2USPQ2d 1880 (Bd. Pat App. & Inter. 1987) .... distribution to government agencies and personnel alone may not constitute publication ...

MPEP 2128.01

Applicants submit, and the submitted declaration by co-inventor Surojit Chatterjee attached in Appendix A supports, that Chatterjee has only been distributed internally inside Oracle International with the intention of remaining confidential, and has not been made accessible to the public.

As Chatterjee has not been made accessible to the public, it does not constitute a printed publication under 35 U.S.C §102. As such, Chatterjee cannot be used to preclude patentability of claims 1-32 under 35 U.S.C. § 103.

**CONCLUSION**

On the basis of the above remarks, reconsideration and allowance of the claims is believed to be warranted and such action is respectfully requested. If the Examiner has any questions or comments, the Examiner is respectfully requested to contact the undersigned at the number listed below.

Respectfully submitted,  
Bingham McCutchen LLP

Dated: October 19, 2004

By: Janet D. Chance  
Janet D. Chance  
Reg. No. 55,048

Three Embarcadero Center, Suite 1800  
San Francisco, CA 94111-4067  
Telephone: (650) 849-4904  
Telefax: (650) 849-4800



PATENT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re the application of: )  
Srivastava, Alok K. et al )  
Application No.: 09/872,647 )  
Filed: May 31, 2001 )  
For: METHOD AND MECHANISM )  
FOR DIAGNOSING COMPUTER )  
APPLICATIONS USING TRACING )

Group Art Unit: 2124

Examiner: Rampuria, Satish

RECEIVED

OCT 27 2004

Technology Center 2100

DECLARATION UNDER 37 CFR § 1.132

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

I, Surojit Chatterjee, declare as follows:

1. I am a co-inventor named in the above identified application, herein referred to as "**the 647 application.**" I am an employee of Oracle International Corporataion of Redwood Shores California, the Assignee of **the 647 application.**
2. I am the author of the document entitled "Trace Navigation and Analyzer Tool Prototype (High Level Design: First Draft)" herein referred to as "**The Document.**"
3. Prior to filing the application, **the Document** had only been distributed internally within Oracle International Corporation, with the intent that it remain confidential, to only those persons who understood the policy of confidentiality regarding the document.

4. **The Document** has not been made accessible or available to the public.
5. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

*Surjit Chatterjee*

\_\_\_\_\_  
\*\*inventor\*\*

*10/15/04*  
\_\_\_\_\_  
Date